

H 3475 PCT/US
Serial No. 09/806,961

Art Unit 1712

REMARKS

The Examiner has issued a restriction requirement identifying 13 alleged separate inventions. Applicants respectfully traverse.

For the sake of brevity, the 13 groupings of claims will not be shown herein as they are very clearly set forth in the Office Action of March 18, 2003. The Examiner asserts that unity of invention is absent under PCT Rule 13.1 because the subject matter of all pending claims allegedly lacks the "same or corresponding special technical features" as prescribed under PCT Rule 13.2. In support of this position, the Examiner asserts that claim 31 embodies the "special technical feature" of Applicants' invention.

Rule 13.2 states that the requirement of unity of invention is met, "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." The term "special technical features" means those technical features that "define a contribution" made by "each of the claimed inventions" over the prior art. In addition, Rule 13.3 allows "a group of inventions" to be claimed in separate claims. They need not be presented as "alternatives within a single claim".

Applicants respectfully submit that the "special technical feature" of the present invention is explained on page 5, at lines 6 - 22, of the specification. The essence of the invention is to provide an improved reactive adhesive that exhibits the requisite flexibility and increased peel strength, especially at temperatures below 0° C. This objective is the common denominator that is achieved by the claimed

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compositions. The claims describe alternatives to this single common inventive concept.

Under M.P.E.P. section 1850, Examiners are directed to permit retention in the same application of claims defining different categories of invention, so long as the requirements of PCT Rule 13.2 are met. In support of the retention of all pending claims within this one application, it is noteworthy that the European Patent Office, acting as the International Examination Authority for the PCT phase of this application, retained *all* claims for examination in this one application. Since the EPO, acting within the guidelines of PCT Rule 13, a rule which also applies to the US national stage of this PCT application, recognized that unity of invention exists, it is respectfully submitted that this restriction requirement is improper and should be withdrawn in its entirety.

Notwithstanding the foregoing remarks, and for the sole purpose of complying with 37 CFR 1.143, Applicants provisionally select the subject matter of Group I for prosecution herein. Further, in response to the requirement to select a single species, Applicants provisionally select the species described as (2) on page 4 of the Office Action. This species applies to the subject matter found within the claims identified under Group I.

Applicants have not cancelled any claims at this time in order to afford the Examiner the opportunity to reconsider and withdraw the restriction requirement. The favorable reconsideration of this restriction and species election is respectfully requested. The Commissioner is hereby authorized to charge any deficiency in the required fee or to credit any overpayment made in connection with this response to Deposit Account 01-1250.

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From-HENKEL CORPORATION PATENT DEPT,

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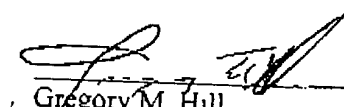
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Applicants also ask that the shortened statutory period to respond to the Restriction Requirement of March 18, 2003, be extended one month from April 18, 2003 to May 18, 2003. Please charge our Deposit Account No. 01-1250 in the amount of \$110.00 for the extension fee. Order No. 03-0233

Respectfully Submitted,


Gregory M. Hill
Reg No 31,369
Attorney for Applicants
(610) 278-4964

Henkel Corporation
Law Department
2500 Renaissance Boulevard, Suite 200
Gulph Mills, PA 19406